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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,729	10/29/2003	Scott Freeberg	279.652US1	6340

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EXAMINER

ROBERTS, DARIN

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,729

Applicant(s)

FREEBERG, SCOTT

Examiner

Darin R. Roberts

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 46-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-45 is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-33, 35, 36, 46-48, 50, 51 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 22, 34, 37, 49 and 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/4/04 and 3/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 & 53-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 11 & 53 are directed toward the claiming of structures being in contact with or implanted within the body, such claiming amounts to an inferential recitation of the body, which renders these claims non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, & 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuelke et al. (US 5755742 A).

In reference to **claim 1**, the Schuelke et al. patent teaches a stimulation device (see abstract) capable of generating a current field in the heart (see abstract). The Schuelke et al. patent also teaches two pairs of electrodes coupled to two different chambers of the heart (see Fig. 1) as well as the generation of impedance information as a function of their respective voltages in response to a current field (see abstract & col. 5 lns. 13-18).

In reference to **claim 4**, the Schuelke et al. patent teaches a device that possess therapy circuits, which are referred to as "the APACE and VPACE output circuits" connected to a processor (see col. 10, lns. 24-28), connected to a microprocessor (see fig. 2) storing information in the form of code is inherent to the properties of a processor.

In reference to **claim 5**, the therapy circuits, APACE and VPACE, acts as pulse generators (see Fig. 1).

Claims 1, 2, 7, 11-15, 17-21, 23-31, 35, 36, 46-48, 50, & 51-53 & 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiebert et al. (US 2003/0114891 A1).

In reference to **claims 1, 2, 7, 11, 14, 15, 17, 20, 21, 25, 26, 28-31, 46, 51-53, & 55**, the Hiebert et al. teaches the use of an implantable device comprising an exciter to generate a current field in a heart, and because the Hiebert et al device is capable of delivering pulses it inherently possesses a pulse generator (see pp. [0004]). Hiebert also teaches a electrodes coupled to a chamber of the heart; and other electrodes coupled to another chamber of the heart (see pps. [0007]-[0008]). Hiebert et al. also teaches the use of a processor coupled to multiple electrodes (see pp. [0033]) and

electrodes adapted to generate impedance information (see pp. [0035]) as well as a code that is a function of a relationship between the impedance information (see pp. [0053] & [0056]). Because changes in impedance can indicate the level of one's activity, the sensors of the Hiebert et al. device can be described as activity sensors. The device also would inherently possess a channel through which one could generate a current field (see pp. [0037]). Hiebert et al. teach the use of an accelerometer and delivering a stimulation regimen based on accelerometer readings (see pp. [0035]).

In reference to **claims 7, 12, 18, 27, 35, & 36, 47, 48**, the Hiebert et al. publication teaches the use of an accelerometer coupled to a processor (see pp. [0035]).

In reference to **claim 13**, the Hiebert et al. device inherently possesses excitation circuitry because it is a stimulation device (see pp. [0004 & [0005]).

In reference to **claims 19, 24**, the Hiebert et al. publication teaches altering the stimulation parameters when a code is presented (see pp. [0053]).

In reference to **claim 23** Hiebert et al. teaches the use of wireless telemetry (see pp. [0025]).

In reference to **claim 33**, because the Hiebert et al. device is a therapy device, it would inherently possess therapy circuitry.

Claims 14 & 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ternes (US 2005/0065443 A1).

In reference to **claim 14 & 17**, Ternes teaches an implantable system comprising a sensor to provide a first signal representative of a first ventilation rate of a heart a second sensor to provide a second signal representative of a second ventilation rate and a processor coupled to the first sensor and coupled to the second sensor and adapted to identify a relationship between the first signal and the second signal and generate a code as a function of the relationship (see pps. [0029] & [0030]). The aforementioned sensors can be described as activity sensors. The Ternes publication also teaches generating a code (see pp. [0045]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiebert et al. (US 2003/0114891 A1).

In reference to **claim 32**, the Hiebert et al. patent does not teach the use of a filtration system in conjunction with the impedance sensors, however it would have been obvious to one of ordinary skill in the art to employ the use of a filter in conjunction with the impedance sensors to prevent the unnecessary activation of stimulation.

Allowable Subject Matter

Claims 38-45 are allowed. The examiner was unable to find a reference that explicitly recited receiving a third signal based on the activity of the heart, and having the second therapy regimen be a function of the third signal.

Claims 8-10, 16, 22, 34, 37, 49, 52, & 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darin R. Roberts whose telephone number is (571) 272-5558. The examiner can normally be reached on 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes can be reached on (571) 272-4955. The fax phone


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Darin Roberts
Patent Examiner
Art Unit 3762

D. R.


Jeffrey Jastrzab
Primary Examiner
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5/29/06